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10/762,423	01/22/2004	Paul B. Moody	260-008	4901
44185 7590 12/05/2007 LOTUS AND RATIONAL SOFTWARE McGuinness & Manaras LLP 125 NAGOG PARK ACTON, MA 01720			LOT9-02003-0109US EXAMINER NICKERSON, JEFFREY L.	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/762,423

Applicant(s)

MOODY ET AL.

Examiner

Jeffrey Nickerson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5508)
- Paper No(s)/Mail Date 12 August 2004
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to Application No. 10/762,423 filed on 22 January 2004. Claims 1-29 have been carefully examined.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 561 (pg 35), 546 (pg 35), 548 (pg 35), 550 (pg 35), and 637 (pg 40). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 70 (Figure 1), 180 (Figure 7), and 304 (Figure 13). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to because a referenced label is inconsistent with the specification's description of the reference character. In Figure 10, the applicant depicts a user controllable drop down box labeled 'Most recent documents' and identified with reference character 243. Given the use of the user controllable drop down box taken from the specification with reference character 243 (pg 26, lines 10-11), the box should be labeled 'Most recent chat partners'. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures

appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities: inconsistent use of reference characters. Page 13, line 9 of the applicant submitted specification contains the reference character "17", when it should be --71--. Page 23, line 23 of the applicant submitted specification contains the reference character "182", when it should be --180--, which would also overcome a previously mentioned drawing objection. Page 28, line 1 contains the reference character "302", when it should be --304--, which would also overcome a previously mentioned drawing objection. Page 39, line 22 of the

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applicant submitted specification contains the reference character "630" when it should either be changed to --632-- or a new reference character. The examiner is uncertain to the changing of this reference character because a second previously objected reference character (637 on pg 40) may be the one that needs to be changed to --632--. Appropriate correction is required.

6. The disclosure is objected to because of the following informalities: incorrect grammar or spelling. Page 21, line 3 of the applicant submitted specification should have the word "and" changed to --an--. Page 36, line 2 should have the second instance of the word "a" removed. Appropriate correction is required.

Claim Objections

7. Claims 7, 16, and 25 are objected to because of the following informalities: incorrect grammar. Each of the preceding claims contains the phrase "presenting an interface to user of" in the first line of the first limitation. This should be changed to "presenting an interface to a user of" or something similar. Appropriate correction is required.

8. Claims 7-9, 16-18, and 25-27 are objected to because of the following informalities: inconsistent use of identifying between the multiple instances of an object. In each of the independent claims 1, 10, and 19, the applicant differentiates between

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the remote user and local user by using the phrases "remote user" or "said remote computer system user" and "local user" or "said local remote computer system user."

However, in the dependent claims listed above, the applicant refers to the user as "said user of said local computer system." Identification of objects with antecedent basis should be kept consistent. Appropriate correction is required.

9. Examiner Note. Claim 10 and its entire dependent chain use "means for" language and thusly it appears the applicant is attempting to invoke 35 USC 112 6th paragraph. However, for the limitations in claim 10, the applicant defines the structure that the means must use, specifically "an awareness client application process executing on a local computer system". Therefore, the limitations of claim 10 do not pass the three pronged test for invoking 35 USC 112 6th paragraph as the language is modified by structure. Claim 10's limitations and its entire dependent chain's limitations will not be treated under 35 USC 112 6th paragraph. It should also be noted that this notice is merely a formality and does not affect the examination of the claim limitations because the structure used in the claim limitations (causing them to not qualify for 35 USC 112 6th paragraph examination) is the exact same structure defined in the applicant's specification (under the description of Figure 1, pg 11-14). Therefore, amending the claims to have the structure removed will not substantially affect any rejection based on prior art.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 19-27 and 29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claim 29, computer-related inventions whether descriptive or functionally descriptive material are non-statutory categories when claimed as descriptive material *per se* (see *Warmerdam*, 33 F.3d at 1360 USPQ2d at 1759), falling under the “process” category (i.e. inventions at that consist of a series of steps or acts to be performed). See 35 U.S.C. 100(b) (“The term process means, art, or method, and includes a new of a known process, machine, manufacture, composition of matter or material”). Functional descriptive material: “data structures” representing descriptive material *per se* or computer program representing computer listing *per se* (i.e. software *per se*) when embodied in a computer-readable media (such as carrier waves or signals) are still not statutory because they are not capable of causing functional change in the computer. However, a claimed computer-readable *storage* medium encoded with a data structure, computer listing or computer program, having defined structural and functional interrelationships between the data structure, computer listing or computer program and the computer software and hardware component, which permit the data structure’s, listing or program’s functionality to be realized, is statutory (see MPEP §2106).

Regarding claims 19-27, these computer program product claims are rejected under similar grounds to that of claim 29. The applicant defines a possible embodiment of a computer program product to be that of a carrier wave or signal (Applicant submitted specification: pg 41, line 22 - pg 42, line 7, particularly item (c) in this paragraph), which is unpatentable subject under 35 USC 101. When one possible embodiment of the claim is unpatentable it renders the entire claim (and in this case, the claim chain) unpatentable.

12. Applicant is advised that should claim 10 be found allowable, claim 28 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Regarding claim 28, the further limiting features over that of claim 10 is that each component of the system is restricted to being "program code, stored in a computer readable memory communicably coupled to at least one processor in a local computer system." This may initially appear as if claim 28 is further limiting each component of claim 10 to be this particular structure. However, upon examining claim 10, the applicant uses the terminology "means for, by an awareness client application process executing on a local computer system", which inherently must be computer instructions stored on a computer readable storage medium on the local computer system that utilizes a processor. Therefore, the limitations in claim 28 are substantial duplicates to that of claim 10.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-2, 8-11, 17-20, and 26-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Cohen et al (US 6,507,845 B1).

Regarding claim 1, Cohen teaches a method of providing remote user activity information regarding recently accessed documents of remote users to a local user, comprising:

obtaining, by an awareness client application process executing on a local computer system (Cohen: Figure 1, item 12 and its contained items), from an associated awareness server application process executing on a server computer system (Cohen: Figure 1, item 10 and its contained items), an online status of said remote computer system user (Cohen: col 2, lines 39-46 specifies that users should have access to online presence information; col 5, lines 31-39 specifies that the collaboration server tracks the online statuses, implying that it is then passed to the local user applications);

presenting, by said awareness client application process, an awareness object associated with said remote computer system user, wherein said awareness object includes an indication of said remote computer system user, wherein said awareness object further includes an indication of said online status of said remote computer system user (Cohen: col 4, lines 42-65 specifies the main three object types, one of which is a user profile containing information about remote users, such as their current online status; col 6, lines 12-29 specifies that once a task or document is retrieved it contains user information, which includes who is assigned to a task or document and which of those persons are currently online);

obtaining, by said awareness client application process on said local computer system, responsive to said presenting said awareness object associated with said remote computer system user, document access activity information regarding said remote computer system user, wherein said document access activity information includes the identity of at least one document accessed by said remote computer system user (Cohen: col 6, line 46 – col 7, line 3 specifies that when a task is retrieved it contains which users are currently online and which document they are currently working on);

detecting a selection of said awareness object associated with said remote computer user by said local computer system user (Cohen: col 6, lines 46-54 specifies the local user selects a task);

presenting, by said awareness client application process, said document access activity information regarding said remote computer system user in a display for said

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local computer system. (Cohen: col 6, line 46 – col 7, line 3 specifies that this information is displayed to the local user via the UI program; See also Figure 16)

Regarding claim 2, Cohen teaches wherein the document access activity information regarding said remote computer system user further comprises a time at which said at least one document was accessed by said remote computer system user. (Cohen: Figure 16, item 232 depicts that each associated action by a user contains time information; col 8, lines 40-50 specifies the document history feature)

Regarding claim 8, Cohen teaches the method further comprising:

presenting an interface to said user of said local computer system, wherein said interface enables said user of said local computer system to specify document access activity information regarding said user of local computer system that is to be shared with other users. (Cohen: col 8, lines 40-50 specify that document activity can be manually entered by a local user to be shared with the other users)

Regarding claim 9, Cohen teaches the method further comprising:

presenting an interface to said user of said local computer system, wherein said interface enables said user of said local computer system to specify one or more other users with which document access activity information regarding said local user is to be shared. (Cohen: col 8, line 51 – col 9, line 7 specify that the via the UI a client may

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select a remote user and choose to share document information with and in turn the remote user's UI toolbar regarding the document access status information is updated)

Regarding claim 10, this system claim comprises limitations substantially similar to that of claim 1 and the same rationale of rejection is used, where applicable.

Regarding claim 11, this system claim comprises limitations substantially similar to that of claim 2 and the same rationale of rejection is used, where applicable.

Regarding claim 17, this system claim comprises limitations substantially similar to that of claim 8 and the same rationale of rejection is used, where applicable.

Regarding claim 18, this system claim comprises limitations substantially similar to that of claim 9 and the same rationale of rejection is used, where applicable.

Regarding claim 19, this computer program product claim comprises limitations substantially similar to that of claim 1 and the same rationale of rejection is used, where applicable.

Regarding claim 20, this computer program product claim comprises limitations substantially similar to that of claim 2 and the same rationale of rejection is used, where applicable.

Regarding claim 26, this computer program product claim comprises limitations substantially similar to that of claim 8 and the same rationale of rejection is used, where applicable.

Regarding claim 27, this computer program product claim comprises limitations substantially similar to that of claim 9 and the same rationale of rejection is used, where applicable.

Regarding claim 28, this system claim comprises limitations substantially similar to that of claim 1 and the same rationale of rejection is used, where applicable.

Regarding claim 29, this carrier wave claim comprises limitations substantially similar to that of claim 1 and the same rationale of rejection is used, where applicable.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 3-6, 12-15, and 21-24 rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen et al (US 6,507,845 B1), and further in view of Begole et al (US 2004/0039630 A1) (referred to as Begole hereafter).

Regarding claim 3, Cohen teaches the method of monitoring document activity information of the remote user and presenting it to the local user, but he does not teach wherein the activity monitored comprises a number of keystrokes and mouse clicks. (See claim 1 rejection)

Begole, in a similar field of endeavor, teaches wherein user document activity is monitored and logged, specifically comprising a number of keystrokes and mouse clicks. (Begole: [0060]-[0062] specifies that the rhythm service logs keystrokes and mouse clicks for particular applications)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Begole for monitoring and logging the keystrokes and mouse activity. The teachings of Begole, when implemented in the Cohen system, will allow one of ordinary skill in the art to track more awareness information about documents. One of ordinary skill in the art would be motivated to utilize the teachings of Begole in the Cohen system in order to create awareness about shared documents or user activities regarding documents and applications.

Regarding claim 4, the Cohen/Begole method teaches wherein said document access activity information (Cohen: col 6, line 46 – col 7, line 3 specifies that when a task is retrieved it contains which users are currently online and which document they are

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currently working on and activity information regarding it) further comprises a name of an application program (Begole: [0113] specifies that data is organized with respect as to which application is handling the activity, such as an email application versus a web browser) used by said remote computer system to access said at least one document. (Cohen: col 6, line 46 – col 7, line 3 specifies that this information is regarding a remote user)

Regarding claim 5, the Cohen/Begole method teaches wherein said document access activity information further comprises actions performed during a document access by the remote user. (Cohen: Figure 16, item 232 depicts the user actions being recorded and displayed; See also col 8, lines 40-50)

Regarding claim 6, the Cohen/Begole method teaches wherein said presenting said document access activity information comprises presenting said document activity information in at least one pop-up display window. (Cohen: Figure 16, item 232 depicts a pop-up window occurring over the UI; See also col 8, lines 17-38)

Regarding claim 12, this system claim comprises limitations substantially similar to that of claim 3 and the same rationale of rejection is used, where applicable.

Regarding claim 13, this system claim comprises limitations substantially similar to that of claim 4 and the same rationale of rejection is used, where applicable.

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Regarding claim 14, this system claim comprises limitations substantially similar to that of claim 5 and the same rationale of rejection is used, where applicable.

Regarding claim 15, this system claim comprises limitations substantially similar to that of claim 6 and the same rationale of rejection is used, where applicable.

Regarding claim 21, this computer program product claim comprises limitations substantially similar to that of claim 3 and the same rationale of rejection is used, where applicable.

Regarding claim 22, this computer program product claim comprises limitations substantially similar to that of claim 4 and the same rationale of rejection is used, where applicable.

Regarding claim 23, this computer program product claim comprises limitations substantially similar to that of claim 5 and the same rationale of rejection is used, where applicable.

Regarding claim 24, this computer program product claim comprises limitations substantially similar to that of claim 6 and the same rationale of rejection is used, where applicable.

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17. Claims 7, 16, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen et al (US 6,507,845 B1), and further in view of Galvin, JR. et al (US 2005/0138108 A1).

Regarding claim 7, Cohen teaches wherein the user awareness information is document access activity information. (Cohen: Figure 16, item 232; See also col 8, lines 40-50) Cohen does not teach wherein the local user has the option to control if the remote users are allowed to see their awareness information.

Galvin JR., in a similar field of endeavor, teaches wherein a local user has the ability to control if, and exactly which, remote users can see the local user's awareness information via presenting an interface (awareness service). (Galvin JR.: [0008]-[0009] specifies the local user's ability to control the awareness information; [0017] specifies that the user is interacting with an interface to set these settings)

Regarding claim 16, this system claim comprises limitations substantially similar to that of claim 7 and the same rationale of rejection is used, where applicable.

Regarding claim 25, this computer program product claim comprises limitations substantially similar to that of claim 7 and the same rationale of rejection is used, where applicable.

Cited Pertinent Prior Art

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Bhaskaran et al (US 6,732,364 B1) discloses a system that utilizes "Awarelets" that monitor and distribute various types of awareness information using various techniques.
- b. Doss et al (US 2003/0046296 A1) discloses a method and system for a calendar based awareness management system for use in instant messaging applications.
- c. Hajmiragha (US 6,289,460 B1) discloses a system for electronic document management and collaboration that utilizes workflow notifications, to-do lists, user access restrictions, etc.
- d. Kaminsky et al (US 2005/0055405 A1) discloses a method for managing awareness and status information in an instant messaging environment.
- e. Porter et al (US 5,845,067) discloses a method and apparatus for document management utilizing a messaging system that includes document access information.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Nickerson whose telephone number is 571-270-3631. The examiner can normally be reached on M-Th, 8:30-6:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beatriz Prieto can be reached on 571-272-3902. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J.N./
Jeffrey Nickerson
Patent Examiner

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Supervisory Patent Examiner, Art
Unit 4117